

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species A (Figs. 1 and 2) and B (Figs. 3 and 4)

The species are independent or distinct because the structures and elements defining each are different than the other, requiring different search and considerations.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic as claims 1-6 correspond to the first species and claims 7-15 are directed to the second species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

2. During a telephone conversation with Mr. Billy A Robbins on Tuesday November 6, 2007 a provisional election was made with traverse to prosecute the invention of Species B, claims 7-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "64" has been used to designate both depression (Fig. 2) and the abrasive particles (Figs. 3, 4). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The disclosure is objected to because of the following informalities: page 4, line 28, reference character (36) should be changed to (14).

Appropriate correction is required.

***Claim Objections***

5. Claims 7-15 are objected to because of the following informalities: the preamble of claim 7 recites for a disposable coated abrasive finishing article (10), but the body of the claims are directed to the nut and the retention member (78).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites for an interference fit between the surface (22) of the nut (18) and the edge (24) of the aperture (16), which renders the claim indefinite since it is unclear what is meant by the term. While for the first embodiment there is an interference fit between the surface (22) and the interior surface of the cylinder (42), such interference fit (as understood by the specification) does not apply to the nut and abrasive pad as shown in the embodiment of Figs. 3 and 4. Rejections under 112, 1<sup>st</sup> paragraph for insufficient disclosure is not applied at this time, since it appears that the claim deficiencies are of clarity and not of enablement. It is also noted that if Applicant wishes to claim a pad with the mounting apparatus/device and/or with a power tool, claims should be presented in a combination type format.

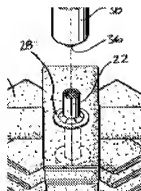
***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth et al (6,368,187).

Wentworth et al meets all of the limitations of claim 7 (as best understood), i.e., a nut (22) having an outer surface engaging an aperture of the pad, and a threaded shank for engaging a driver member of a power tool; a retention member (28) with an interference fit (press fitted) with the shank, except for disclosing an externally threaded shank for the nut. The internally threaded shank as disclosed by Wentworth et al. is designed for an externally threaded or a male power tool drive member, however modifying it by providing external threads in adapting the nut for an internally threaded or a female drive member would have been obvious to one of ordinary skill in the art, and since it has been held that changing shape, dependent on work-piece parameters, involves only routine skill in the art. *In re Stevens*, 101 US PQ 284(CCPA1954).



Regarding claims 8-15 as best understood, Wentworth et al. meets all of the limitations, except for disclosing the choice of preferred material. Note that the mounting assembly of Wentworth is disposable, i.e., it may be disposed after first use or after several uses and that it may be applied to abrasive finishing articles as recited in the preamble known in the art. With regards to choice of materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use hard plastic, e.g., polyvinylchloride, for economical reasons and/or to prevent damaging the workpiece, since it has been held to be within the general skill of a worker in the art

to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Conclusion***

10. Prior art made of record and not relied upon at this time, are considered pertinent to applicant's disclosure. Mackay, Tseng, Mackay, Jr., Mauck, and Tocci are cited to show related inventions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 7, 2007

/Hadi Shakeri/  
Primary Examiner, Art Unit 3723